

REMARKS

Claims 1 to 24 were pending in the application at the time of examination. Claims 1 to 24 stand rejected as obvious.

Applicant(s) have amended the description to correct typographical and grammatical errors.

The Examiner objected to Fig. 2. As explained above, a replacement sheet has been submitted with reference number 250 consistently labeled as a document file. Applicants request reconsideration and withdrawal of the objection to the drawings.

Applicants have amended Claims 1, 10, 12, 15, and 22 to clarify that the reference database is a database that includes reference data that is cited in the other data. This was done to remove any confusion as to inherent characteristics of the elements recited in the claims that should be considered in an obviousness rejection.

Claims 3 to 9, 11, 13, 14, and 20 were amended to correct a grammatical informality.

Claims 8 and 9 were also amended to clarify an inherent characteristic on how the method was stored.

Claims 1 to 5, 7 to 19, and 22 to 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,289,342 B1, hereinafter Lawrence, in view of U.S. Patent No. 6,507,858 B1, hereinafter Kanerva.

The Examiner stated:

Regarding claims 1, 12, 15, and 22, **Lawrence et al.** teaches a method, computer program, and storage medium for creating a reference database for a computer-readable document comprising:

- a). entering inputted reference data into a reference database (col. 6, lines 42-52; and
- b). storing the reference database and other data of the computer-readable document (col. 8, lines 12-17).

Lawrence et al. does not explicitly teach a step of storing the **reference database and other data** of the computer-readable document in a **single data file**.

Kanerva et al., however, teaches a step of storing, viewing, editing, and processing ordered sections having **differing file formats in a compound document**(col. 3, lines 23-27).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to store document related data in the same file because doing so would ensure that reference data is always available for access.

Applicants respectfully note that Lawrence teaches "an autonomous citation indexing system." Lawrence, Abstract, line 1. The system automatically searches for documents containing user specified keywords. The database that is created is based upon processing of these documents. Accordingly, Lawrence teaches away from "entering user inputted reference data into the reference database."

Also, Lawrence teaches that the information in the database is not associated with any particular application program, but rather is parsed document information. Specifically, Lawrence teaches:

. . . a new database is created in order to store **parsed document information**. The database contains the following information: text from the document, the URL of the document, word frequency information for the text of the documents, and citations, the text and context of citations, parsed subfield information, and the syntax of queries that are made to the database. (Emphasis added.)

Lawrence, Col. 8, lines 11 to 17.

The secondary reference, Kanerva, teaches a complex system for storing sections "within the binder file 38 along with the order of the sections. . . Each section is maintained in a file format native to the application program that created each section." Kanerva, Col. 11, lines 31 to 35.

Kanerva also teaches that based upon the application programs, "the binder program module 37a can sequentially dispatch application program modules 37b-c to perform data processing tasks in an uninterrupted, consecutive manner on each of the sections of binder file 38." Kanerva, Col. 11, lines 39 to 42.

Adding a database of Lawrence to the binder file of Kanerva would require a modification to the principles of operation of Kanerva because the database of Lawrence, as quoted above, is "parsed document information", and so would not be associated with one of the applications in the suite of applications of Kanerva. Thus, the information of Lawrence would not be amenable to being processed by the binder program module described by Kanerva.

The MPEP states:

THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF
OPERATION OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

MPEP § 2143.02, 8th Ed. Rev 1., p. 2100-127, (Feb. 2003).

Therefore, Applicants respectfully submit that in view of the directive of the MPEP, the obviousness rejection of Claim 1 is not well founded for multiple reasons. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 1.

Claims 2 to 5 and 7 to 9 depend from Claim 1 and distinguish over the combination of references for at least the same reasons as Claim 1. Applicants request reconsideration

and withdrawal of the obviousness rejection of each of Claims 2 to 5 and 7 to 9.

Claim 6 stands rejected as obvious in view of Lawrence and Kanerva taken together with U.S. Patent No. 5,097,418, hereinafter Nurse. However, assuming that the combination of the three references is correct and that the interpretation of the three references is correct (Applicants note that by making these assumptions Applicants do not concede that either of these facts is correct), the additional information from the third reference does not correct the deficiencies of the two primary references as noted above with respect to Claim 1. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 6.

The obviousness rejection of Claim 10 relied upon the same information as discussed above for Claim 1. Claim 10 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 10 and is incorporated herein by reference.

Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 10.

Claim 11 depends from Claim 10 and so distinguishes over the combination of references for at least the same reasons as Claims 10. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 10.

The obviousness rejection of Claim 12 relied upon the same information as discussed above for Claim 1. Claim 12 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 12 and is incorporated herein by reference.

Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 12.

Claims 13 and 14 depend from Claim 12 and so distinguish over the combination of references for at least the same

reasons as Claim 12. Applicants request reconsideration and withdrawal of the obviousness rejections of Claims 13 and 14.

The obviousness rejection of Claim 15 relied upon the same information as discussed above for Claim 1. Claim 15 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 15 and is incorporated herein by reference. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 15.

Claims 16 to 19 depend from Claim 15 and so distinguish over the combination of references for at least the same reasons as Claims 15. Applicants request reconsideration and withdrawal of the obviousness rejections of each of Claims 16 to 19.

In the obviousness rejection of Claim 20, the Examiner cited an additional reference. However, assuming that the combination of the three references is correct and that the interpretation of the three references is correct (Applicants note that by making these assumptions Applicants do not concede that either of these facts is correct), the additional information from the third reference does not correct the deficiencies of the two primary references as noted above with respect to Claim 15. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 15.

Claim 21 depends from Claim 20 and so distinguishes over the combination of references for at least the same reasons as Claims 20. Applicants request reconsideration and withdrawal of the obviousness rejections of Claim 21.

The obviousness rejection of Claim 22 relied upon the same information as discussed above for Claim 1. Claim 22 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 22 and is incorporated herein by reference. Applicants

request reconsideration and withdrawal of the obviousness rejection of Claim 22.

Claims 23 and 24 depend from Claim 22 and so distinguish over the combination of references for at least the same reasons as Claims 22. Applicants request reconsideration and withdrawal of the obviousness rejections of Claims 23 and 24.

Claims 1 to 24 remain in the application. Claims 1, 3 to 15, 20, and 22 have been amended. For the foregoing reasons, Applicants respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicants.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 25, 2003.

Respectfully submitted,



Forrest Gunnison
Attorney for Applicant(s)
Reg. No. 32,899
Tel.: (831) 655-0880


Attorney for Applicant(s)

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Date of Signature